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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,497	07/29/2003	Barry P. Lubart	GB920030044US1(1397-2U)	9688
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EXAMINER				
VETTER, DANIEL				
ART UNIT		PAPER NUMBER		
3628				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,497

Applicant(s)

LUBART, BARRY P.

Examiner

DANIEL P. VETTER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40, 41, 44 and 46-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40, 41, 44 and 46-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 40, 41, and 43-50 were previously pending in this application. Claims 40, 41, 44, 46, 47, and 49 were amended, and claims 43 and 45 were canceled in the reply filed August 26, 2008. Claims 40, 41, 44, and 46-50 are currently pending in this application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 26, 2008 has been entered.

Response to Arguments

3. Examiner notes the amendments to claims 44 and 46. However, the amended limitations suffer from the same deficiencies under § 112, second paragraph. Namely, it still seems that the activity of billing is required to meet the limitations of the claim. Would an alleged infringing device be required to actually bill the recipient/sender to infringe claims 44 and 46? Or would simply the creation of such a device with all the structural elements be sufficient to infringe, regardless of whether or not it ever actually bills a recipient/sender? While functional limitations are permissible in apparatus claims, the language used in claims 44 and 46 seems directed to actual steps rather than intended functions of positively recited structural limitations. "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

4. Applicant's arguments with respect to the Lorch reference have been considered but are moot in view of the new ground(s) of rejection. Examiner notes the addition of a return address to the registered profile. However, Lorch teaches the necessity and use of return addresses in the art, as well as the similar characteristics that return addresses share with recipient addresses, and it would have been obvious to include them in the profile for similar reasons that it would have been obvious to include a sender pseudo name on a mail piece set forth previously in the rejection of canceled claim 45.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 40, 44, and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 40 recites a "means for registering a pseudo name and providing instructions" This limitation is being interpreted as invoking § 112, sixth paragraph. The corresponding structure for a computer-implemented function in a § 112, sixth paragraph limitation must include the algorithm as well as the general purpose computer or microprocessor. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). An indefiniteness rejection is appropriate if the written description of the specification discloses no corresponding algorithm. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1337-38, 86 USPQ2d 1235, 1243 (Fed. Cir. 2008). The program structure used in the specification for "registering a pseudo name and providing instructions" cannot be determined. Paragraph 0041 of the published application sets forth that: "A pseudo name can be registered, profiles created and modified by using an Internet based service or through any designated central reservation management facility." However, this does not provide sufficient specificity to determine the structure used for registering,

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and thus the scope of the limitation cannot be ascertained. Claims 44 and 46 inherit the above deficiency through dependency and, as such, are rejected for the same reasons.

8. Claims 44 and 46 are directed to a "system" and therefore not considered processes for the purposes of § 101. However, these claims recite actions or steps as part of the system (e.g., "the means for executing bills the recipient"). A single claim that claims both an apparatus and the method steps of using the apparatus is indefinite. *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005). These claims do not properly apprise the public as to what would constitute infringement (i.e., creation of the claimed system or the act of using it) and accordingly are rejected as vague and indefinite under § 112, second paragraph.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 40, 41, 44, 47, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorch, et al., Intl. Pat. Pub. No. WO 02/51051 (Reference 1 of the IDS submitted 5/23/2005).

11. As per claim 40, Lorch teaches a system for routing a mail object in a postal service to a designated person, the system comprising: means for registering a pseudo name (pg 11, line 18) and providing instructions for one or more mail services in a user profile associated with the pseudo name (pg 11, lines 8-10, 19-21), the user profile having: a franking profile including a method of payment for a mail object (pg 23, lines 8-11); a naming profile including name and address information for an associated user (pg 19, lines 15-17), the address information containing an addressee address (Fig. 3); a dynamic mail function profile including a listing of the one or more mail services associated with the pseudo name (pg 22, lines 9-12); and a designated time frame for

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which the user profile is active (pg 20, line 8); means for determining a registered pseudo name to locate the user profile associated with the registered pseudo name (pg 12, lines 4-6); and means for executing the instructions for the one or more mail services during the designated active time frame in the user profile (pg 12, lines 7-8, 14-15).

Lorch does not explicitly teach that the naming profile also includes a return to address. However, this difference is solely found in the non-functional descriptive material of the stored address data itself. Non-functional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339; 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); cf. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). The return to address included in the user profile has no functional relationship with any other recited element of the claim.

Moreover, even if a functional relationship between the return address and the rest of the invention existed, its inclusion would still be obvious based upon Lorch's disclosure. Lorch teaches that a sender name and physical address is placed on the mail object to identify a sender of the mail object (Fig. 1), and that recipient/sender addresses share the same format and represent physical locations (Fig. 1). Therefore, a sender address can also serve as a recipient address without any modification. Additionally, the usefulness of the pseudo name as suggested by Lorch is applicable for sender (return) as well as recipient addresses. The advantage of the pseudo name is that it allows physical address delivery without the other party knowing the physical address (pg 16, lines 12-14). This premise is also applicable to return mail, as senders may wish to keep their physical address unknown for the same reasons as recipients, but may still desire return correspondence from the initial recipient. Additionally, this allows businesses to use an easy-to-remember return address for consumer response correspondence, a use explicitly suggested by Lorch (pg 35, lines 3-14). It would have

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been prima facie obvious to one having ordinary skill in the art at the time of invention to include a return to address into the user profile because this is simply a combination of old elements already known in the art. In the combination no element would have served a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results.

12. As per claim 41, Lorch teaches a computer readable storage medium having a computer readable program for a mail service which when executed on a computer causes the computer to: store a pseudo name to be displayed on a mail object (pg 10, lines 2-3); store a user profile associated with the pseudo name (pg 28, lines 12-14), the user profile including: a franking profile including a method of payment for a mail object (pg 23, lines 8-11); a naming profile including name and address information for an associated user (pg 19, lines 15-17), the address information containing an addressee address (Fig. 3); a dynamic mail function profile including instructions for one or more mail services associated with the pseudo name (pg 22, lines 9-12); determine the registered pseudo name displayed on the mail object to locate the user profile (pg 10, lines 12-13); and store a designated time frame for which the user profile is active (pg 22, lines 14-16). Lorch does not explicitly teach that the naming profile also includes a return to address; however this feature would have been obvious to incorporate for the same reasons set forth above with respect to claim 40.

13. As per claim 44, Lorch teaches the system of claim 40 as described above. Lorch further teaches the means for executing bills the recipient for the one or more mail services associated with the pseudo name according to the method of payment for the mail object included in the franking profile (pg 37, lines 11-13).

14. As per claim 47, Lorch teaches the medium of claim 41 as described above. Lorch further teaches instructions which cause the computer to have the pseudo name placed on the mail object to identify a recipient of the mail object (pg 34, lines 9-12).

15. As per claim 48, Lorch teaches the medium of claim 47 as described above. Lorch further teaches instructions which cause the computer to bill the recipient for the

one or more mail services associated with the pseudo name according to the method of payment for the mail object included in the franking profile (pg 37, lines 11-13).

16. As per claim 49, Lorch teaches the medium of claim 41 as described above. Lorch further teaches instructions which cause the computer to: have the pseudo name placed on the mail object to identify a recipient of the mail object (pg 11, lines 12-14); and also teaches that a sender name and physical address is placed on the mail object to identify a sender of the mail object (Fig. 1); however does not explicitly teach that the pseudo name is placed on the mail object to identify a sender of the mail object rather than the recipient. Thus, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of the physical sender address with a pseudo address (rather than just the recipient address). Both addresses share similar characteristics and functions. They are formatted in the same manner and both identify physical locations. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate a sender pseudo name because it is merely the simple substitution of one known element for another that could be implemented through routine engineering to produce only predictable results. Moreover, the usefulness of the pseudo name as suggested by Lorch is applicable for sender (return) as well as recipient addresses. The advantage of the pseudo name is that it allows physical address delivery without the other party knowing the physical address (pg 16, lines 12-14). This premise is also applicable to return mail, as senders may wish to keep their physical address unknown for the same reasons as recipients, but may still desire return correspondence from the initial recipient. Additionally, this allows businesses to use an easy-to-remember return address for consumer response correspondence, a use explicitly suggested by Lorch (pg 35, lines 3-14).

17. Claims 46 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorch, et al. in view of Law, U.S. Pat. No. 7,072,845 (Reference A of the PTO-892 part of paper no. 20071119).

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18. As per claim 46, Lorch teaches the system of claim 45 as described above. Lorch does not explicitly teach the means for executing bills the sender for the one or more mail services associated with the pseudo name according to the method of payment for the mail object included in the franking profile; which is taught by Law (col 3, lines 46-56; col 5, lines 1-8). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Law because this is merely a combination of old elements. In the combination each element would have performed the same function as it did separately, and one skilled in the art would have recognized that the results of the combination could be implemented through routine engineering producing predictable results.

19. As per claim 50, Lorch teaches the medium of claim 49 as described above. Lorch does not explicitly teach instructions which cause the computer to bill the sender for the one or more mail services associated with the pseudo name according to the method of payment for the mail object included in the franking profile; which is taught by Law (col 3, lines 46-56; col 5, lines 1-8). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Law because this is merely a combination of old elements. In the combination each element would have performed the same function as it did separately, and one skilled in the art would have recognized that the results of the combination could be implemented through routine engineering producing predictable results.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628